Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1970.

No. 617

THE CHEMITHON CORPORATION,
Petitioner,

vs.

THE PROCTER & GAMBLE COMPANY AND THE PROCTER & GAMBLE MANUFACTURING COMPANY,
Respondents.

PETITIONER'S REPLY BRIEF.

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THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

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Question 1 Is Raised by the Record.

The District Court *did* find that P&G withheld from the public critical information necessary to enable practice of the invention.

Specifically, the District Court found that the patented processes embodied three critical process limits (Op., A. 22, 27, 29) knowledge of which was required to enable practice of the inventions by one skilled in the art (Op., A. 26, 29).

The District Court also found that P&G deliberately withheld all process limits from the public (Op., A. 44).

By withholding all process limits from the public, P&G necessarily withheld the three *critical* process limits.

P&G's Conduct Violated a Condition for Public Use Enunciated in the Electric Storage Battery Case.

Electric Storage Battery Co. v. Shimadzu, 307 U. S. 5 (1939) indicates that there is no public use of patented inventions where "efforts were made to conceal them from anyone who had a legitimate interest in understanding them". 307 U. S. at 20. Here, P&G had an express written policy requiring the withholding of process limits from college engineering professors and their students on field trips at P&G (Op., A. 38). There was thus an effort to conceal critical information, required to practice the inventions, from persons having a legitimate interest in understanding them.

The Requirements for Public Use and Printed Publication Are the Same.

When it comes to invalidating a patent, the requirements for a public use are the same as the requirements for a printed publication. They both must give the public the opportunity to acquire such knowledge as would enable one skilled in the art to practice the invention (see cases cited on pages 8-9 of the Petition). That the requirements are the same is not surprising inasmuch as both fall within the same sentence of the same sub-section of the same statute, 35 U. S. C. § 102(b):

> "A person shall be entitled to a patent unless—the invention was patented or described in a *printed publication* in this or a foreign country *or in public use* or on sale, more than one year prior to the date of the application for patent in the United States,".*

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* Emphasis is always added.

Prior Use by the Patentee Is Not Equatable With Public Use by Another.

P&G contends that a prior use which does not make the invention available to the art can invalidate a patent. This is true only as to a prior use by the inventor or patentee; it is not true for a prior use by someone other than the patentee. *Koehring Company* v. *National Automatic Tool Company*, 362 F. 2d 100, 103 (7th Cir., 1966).

The distinction between the two types of cases was noted by Judge Learned Hand, in *Metallizing Engineering Co.* v. *Kenyon Bearing & A. P. Co.*, 153 F. 2d 516, 519 (2nd Cir., 1946):

> "In *Gillman* v. *Stern*, *supra* (114 F. 2d 28, 46 PQ 430), it was not the inventor, but a third person who used the machine secretly and sold the product openly, and there was therefore no question either of abandonment or *forfeiture by the inventor*. The only issue was whether a prior use which did not disclose the invention to the art was within the statute; and it is well settled that it is not."

The three cases P&G cites on pages 11-12 are inapplicable here because each involved a prior use by the *inventor* rather than by someone other than the inventor.

Respectfully submitted,

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